



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/584,610	05/31/00	NERENBERG	A NERE-2842

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QM12/0929

EXAMINER

RIMELL, S

ART UNIT	PAPER NUMBER
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3712

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DATE MAILED: 09/29/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/584,610

Applicant(s)

NERENBERG ET AL.

Examiner

Sam Rimell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

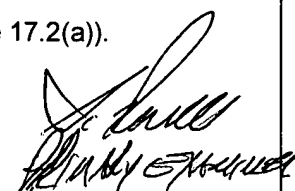
- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) ____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____



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35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-34 are rejected under 35 U.S.C. 101 because they are directed to non-statutory subject matter.

Claims 22-34 are additionally rejected under 35 USC 101 as lacking utility.

Claims 1-18: Independent claim 1 includes the step of “prompting the first person to express to the second person an emotion that the first person has in relation to the second person.” This step is actually two discrete steps, the first being the step of “prompting” and the second being the step of “expressing an emotion”. The latter step of expressing an emotion is a thought process carried out by a human being, and as such, is not patentable under 35 USC 101.

Claims 19-21: Independent claim 19 calls for the step of “pretesting a first person for a contradiction against continuing with the method” and “if the pretesting step fails to disclose the contradiction, providing a coffin...” The determination of a failure in this context is the result of a thought process performed by a human being, and as such, is not patentable under 35 USC 101. In addition, the last paragraph of claim 19 contains the same step of expressing an emotion as claimed in claim 1. Accordingly, such a step is deemed to be a human thought process and is not patentable under 35 USC 101.

Claims 22-33: Independent claim 22 is addressed to a therapeutic structure, and claims that one of the structures is “an expression of an emotion”. Since term “expression of emotion” is in fact broad enough to encompass a thought process by a human being (as evidenced by claim 28), the step makes the structure non-statutory under 35 USC 101. In addition, since the

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“expression of emotion” is not necessarily a structure, it lacks any utility in the context of claim requiring a structure. Thus, the therapeutic structure as a whole is lacking in utility.

Claim 34: Independent claim 34 calls for a “therapeutic strucutre” and requires that “an emotion that the first person has in relation to the second person is expressed”. Since an expression of emotion is broad enough to encompass a thought process by a human being, the step makes the structure non-statutory under 35 USC 101. In addition, since the “expression of emotion” is not necessarily a structure, it lacks any utility in the context of a claim requiring a strucutre. Thus, the therapeutic structure as a whole is lacking in utility.

This office action does not include a Notice of References. A signed copy of Applicant’s Information Disclosure Statement is included with this action.

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (703) 306-5626.



Sam Rimell
Primary Examiner
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